

Attorney Docket No. 07414.0104-01000
Serial No. 09/724,730

REMARKS

Claims 1 to 12 have been amended. Claims 27 to 38 have been added. Claims 1 to 12 and 27 to 38 are currently pending. Support for the amendments to claim 1 may be found, e.g., at Figure 4C, at page 19, lines 13 to 24, at page 8, line 22, to page 9, line 7, and at page 11, lines 28 to 32. The term "portion" was removed from claims 5, 6, 7, and 9 so that the language of those claims more closely tracks the language of claim 1. Claim 9 was also amended to remove the language "mobility modifier comprises" because claim 1 already indicates that the first mobility modifier comprises a first tail. The phrase "the group consisting of" was also removed from claims 8 and 11, and the deletion of that phrase does not narrow the scope of those claims in any way. Claims 7 and 10 were also amended to change the word "is" to the word "comprises", and claim 8 was amended to change the word "are" to the word "comprise".

Support for new claim 27 may be found, e.g., at originally-filed claim 1, at Figure 4C, at page 8, line 22, to page 9, line 7, and at page 19, lines 13 to 24. Support for new claims 28 to 38 may be found, e.g., at originally-filed claims 2 to 12 (as renumbered by the Examiner).

The amendments add no new matter. Also, Applicant reserves the right to pursue the subject matter of previously pending claim 1 (before the amendments) in a continuing application.

The undersigned thanks Examiner Switzer and Examiner Fredman for the personal interview on July 22, 2003. The following remarks provide the substance of the interview and expand upon the interview.

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First, the Examiner rejected claims 1 to 12 under 35 U.S.C. § 112, first paragraph, as allegedly "containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Action at page 2, item 3. During the interview, the undersigned pointed to page 11, lines 28 to 32, as exemplary support for the pending claim language. The Examiner proposed amending claim 1 to more closely track the language at page 11, lines 28 to 32, of the specification. The Examiner tentatively agreed that a claim with such language may obviate the § 112, first paragraph, rejection.

Solely to expedite prosecution and not acquiescing to the rejection, Applicant amended claim 1 to read in part "a first tag that does not comprise any portion of the target-specific portion of the first probe . . ." and "a second tag that does not comprise any portion of the target-specific portion of the second probe" Thus, Applicant asserts that the § 112, first paragraph, rejection is moot.

Second, the Examiner rejected claims 1 to 12 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,514,543 (Grossman). Action at page 3, item no. 6. During the interview, Examiner Switzer suggested that adding the target nucleic acid sequence as an element of the claim would obviate the § 102 rejection.

Solely to expedite prosecution and not acquiescing to the rejection, Applicant amended claim 1 to include the language "a first nucleic acid sequence comprising a first target nucleic acid sequence . . ." and "a second nucleic acid sequence comprising a second target nucleic acid sequence" Thus, Applicant asserts that the § 102(b) rejection is moot.

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